

REMARKS

Claims 1-13 and 22-30 are pending in this application. Claims 1, 3, 5, 6, 8-13 and 22-30 stand rejected. Claims 2, 4 and 7 stand objected to as dependent upon a rejected base claim but indicated as allowable if rewritten in independent form.

Claims 2, 4 and 7 have been rewritten in independent form and hence are allowable for the reasons stated in the Office Action. No new matter is introduced by any of the foregoing amendments.

Claims 1, 3, 5, 6, 8-13 and 22-30 stand rejected under 35 USC 103(a) as being unpatentable over Duthaler et al, U.S. Patent Publication No.2003/0214697, in view of Hakamata, U.S. Patent No. 6,204,556. This rejection is traversed. More specifically, this rejection is traversed on the grounds that:

(a) as regards claims 1, 3, 5, 6, 8-13, 22, 24-26 and 30 the use of Duthaler in support of a 35 USC 103(a) rejection is barred by 35 USC 103(a); and

(b) as regards claims 23 and 27-29, neither Duthaler nor Hakamata describes an article of manufacture comprising a layer of a solid electro-optic medium sandwiched between two adhesive layers, as required by these claims, and hence these claims are not obvious over the combination of Duthaler and Hakamata.

With regard to ground (a), Duthaler was published on November 20, 2003. Although the present application was filed February 10, 2004, it claims priority from provisional Application Serial No. 60/319,934, filed February 11, 2003, and applicants were in possession of the invention of each of claims 1, 3, 5, 6, 8-13, 22, 24-26 and 30 at the time this provisional was filed, as shown by the following table, which sets out at least part of the basis for each of these claims in the provisional application:

<u>Claim No.</u>	<u>Basis in Provisional</u>
1	"Claim" 1
2	Paragraph 31
3	Figure 2 and Paragraph 34
4	Paragraph 38, first sentence
5	Paragraph 38, second sentence
6	Paragraph 38, third sentence
7	Paragraph 38, fifth sentence
8	Paragraph 38, sixth sentence
9	Paragraph 38, last four sentences
10	Paragraph 37, first sentence
11	Paragraph 39, last sentence
12	Paragraphs 4, 10, 5 and 6
13	Paragraph 7
22	Figure 1 and Paragraphs 24-29
24	Paragraphs 4, 10, 5 and 6
25	Paragraph 6
26	Paragraph 3
30	Paragraph 3

Since applicants were in possession of the invention of each of claims 1, 3, 5, 6, 8-13, 22, 24-26 and 30 at the February 11, 2003 filing date of the provisional, which is earlier than the publication date of Duthaler, Duthaler is not available under 35 USC 102(a) or (b), and hence the only conceivable basis for the use of Duthaler as prior art is 35 USC 102(e). However, since Duthaler is assigned to the same assignee as the present application, use of Duthaler in support of a 35 USC 102(e)/103 rejection (which is what the 35 USC 103 rejection in the Office Action must be) is barred by 35 USC 103(c).

35 USC 103(c)(1) provides that subject matter developed by another person which qualifies as prior art only under one or more of subsections (e), (f), and (g)

of 35 USC 102 shall not preclude patentability under 35 USC 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The present application and Duthaler satisfy the requirements of 35 USC 103(c)(1). As may readily be seen from Office records, Duthaler is assigned to E Ink Corporation of 733 Concord Avenue, Cambridge MA by an assignment recorded as Reel 13775, Frame 234. Similarly, the present application is assigned to the same assignee by an assignment recorded as Reel 14999, Frame 0422. Furthermore, the undersigned attorney, who is the Intellectual Property Counsel of E Ink Corporation, the assignee of both Duthaler and the present application, hereby states, of his own personal knowledge, that at all relevant times the inventors of Duthaler and the present application were employed by E Ink Corporation under contracts of employment which required them to assign their inventions to E Ink Corporation.

For the foregoing reasons, Duthaler is not available in support of a 35 USC 103 rejection of claims 1, 3, 5, 6, 8-13, 22, 24-26 and 30, and since it is clear that Hakamata alone cannot support the rejection, the 35 USC 103 rejection of claims 1, 3, 5, 6, 8-13, 22, 24-26 and 30 is unjustified.

With regard to ground (b), claims 23 and 27-29 all require an article of manufacture comprising a layer of a solid electro-optic medium having first and second surfaces on opposed sides thereof, a first adhesive layer on the first surface of the layer of electro-optic medium, and a second adhesive layer on the second surface of the layer of electro-optic medium. In other words, these claims essentially require a layer of electro-optic medium sandwiched between two adhesive layers. No such structure is disclosed in either Duthaler or Hakamata; in all the disclosed structures there is only a single layer of adhesive. The Office Action states "It would have been obvious to include a second adhesive layer for the purpose of securing the electro optic medium". With respect, it is entirely unclear why a person skilled in the technology of electro-optic displays would be lead to add a second layer of adhesive at the relevant location (for example, between the

layers 400 and 440 in Duthaler's Figure 18A). The single layer of adhesive in Duthaler is provided to enable the electro-optic medium to a backplane; there is no need for any corresponding adhesive layer on the other side of the electro-optic medium, since the combination of layers 462/440/400 is produced as an integral unit. Since (absent the teaching of copending Application Serial No. 10/605,024, Publication No. 2004/0155857, discussed in Paragraph 26 of the present application, regarding a double lamination process not contemplated by either Duthaler or Hakamata) neither Duthaler nor Hakamata describes a second adhesive layer, and there is no logical reason why a skilled person would incorporate such a layer, claims 23 and 27-29 cannot be obvious over Duthaler and Hakamata.

For the foregoing reasons, the 35 USC 103 rejection in the Office Action is unjustified and should be withdrawn. Accordingly, reconsideration and allowance of all claims remaining in this application is respectfully requested.

While preparing this Amendment, the undersigned attorney has reviewed the question of the inventorship of this application, and has realized that the cancellation of the non-elected claims 14-21 in the Amendment and Response to Office Action filed May 27, 2005 should have been accompanied by a Petition to Correct Inventorship. The undersigned attorney would apologize for failing to file the Petition at the appropriate time, and the necessary Petition is filed herewith.

Webber et al.
Serial No. 10/708,121
Amendment of April 28, 2005
Page 10

A Patent Application Fee Determination Record (Form PTO/SB/06) and a Petition for a two month extension of the prescribed period for responding to the Office Action are also filed herewith. The additional claim fees and fees for the Petitions are being charged to the assignee's Deposit Account simultaneously with the filing of this Amendment.

Respectfully submitted
/Shipley/
David J. Cole
Registration No. 29629

E INK Corporation
733 Concord Avenue
Cambridge MA 02138

Telephone (617) 499-6069
Fax (617) 499-6200
E-mail dcole@eink.com